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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,797	10/19/2001	Jen-Hwang Weng	BHT-3167-22	6951

7590 05/25/2005

DOUGHERTY & TROXELL  
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FALLS CHURCH, VA 22041

EXAMINER
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RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/981,797

Applicant(s)

WENG, JEN-HWANG

Examiner

Laurie Ries

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is responsive to communications: amendment, filed 22 February 2005, to the original application filed 19 October 2001,

The objection to the specification has been withdrawn as necessitated by amendment.

The objection to claims 1-2, 4-5, 9 and 13 has been withdrawn as necessitated by amendment.

The rejection of claims 1-14 under 35 U.S.C. 112, first paragraph, has been withdrawn as necessitated by amendment.

Claims 1-3, 5-12 and 14 are pending. Claims 4 and 13 have been cancelled. Claims 1 and 8 are independent claims.

### ***Response to Arguments***

Applicant's arguments, see amendment, filed 22 February 2005, with respect to the rejection(s) of claim(s) 1-14 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of 35 U.S.C. 103(a).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sidana (U.S. Patent 6,571,295 B1) in view of Boys (U.S. Patent 6,516,340 B2).

As per claims 1 and 8, Sidana discloses a system and method for providing online web page annotations, or reading records, allowing a number of users to process annotations, or reading records, including displaying a web page and related annotations, or reading records, in a browser of an end user, the related annotations, or reading records, distinguished by the end user's identification data (See Sidana, Column 11, Claim 11, and Column 12, Claim 14), receiving annotations, or reading records, entered by the end users through the annotation, or reading record, function on the web page (See Sidana, Figure 7, and Column 7, lines 13-41), and storing the users' identification information and related annotated web pages (See Sidana, Column 12, Claim 14). Sidana does not disclose expressly providing a number of annotation, or reading record, functions on the web page and instantly displaying the annotations, or reading records, on the web page. Boys discloses annotation tools, equivalent to reading record functions (See Boys, Column 6, lines 34-43). Boys also discloses

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displaying the annotations on the web page (See Boys, Column 8, lines 22-24). Sidana and Boys are analogous art because they are from the same field of endeavor of annotating or modifying the contents of web documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the annotation tools and instant display of modified web pages of Boys with the system and method of processing documents of Sidana. The motivation for doing so would have been to enhance and store selected web pages and to provide the content to users (See Boys, Column 2, lines 42-53). Therefore, it would have been obvious to combine Boys and Sidana for the benefit of enhancing and storing selected web pages and providing the content to users to obtain the invention as specified in claims 1 and 8.

As per claims 2 and 9, Sidana and Boys disclose the limitations of claims 1 and 8 as described above. Sidana also discloses that the annotation, or reading record, functions allows the end user to insert a web page object on the web page and immediately display an inserted object on the page by making the related HTML code of the web page object insert the inserted object in a selected location in real time (See Sidana, Column 6, lines 56-67, and Column 7, lines 1-7).

As per claims 3 and 10, Sidana and Boys disclose the limitations of claims 1 and 8 as described above. Sidana also discloses that the annotation, or reading record, functions provides a means for the end user to change the format attributes of a selected portion on the web page and the web page will immediately display the changed format on the selected portion by replacing the selected portion with the

related HTML codes in real time on the web page (See Sidana, Column 12, Claim 21, Column 10, lines 58-67, and Column 11, lines 1-4).

As per claims 5 and 11, Sidana and Boys disclose the limitations of claims 2 and 9 as described above. Sidana also discloses that the inserted object can be a text object (See Sidana, Figure 7, element 712) or a hyperlink object linking to a selected address (See Sidana, Column 11, lines 1-10, Column 7, lines 59-67, and Column 8, lines 1-34), which are two of the possible types presented in claims 5 and 11.

As per claims 6 and 12, Sidana and Boys disclose the limitations of claims 3 and 10 as described above. Boys also discloses that the functions required to change format attributes or its displayed characteristics to the portion of the web page include adding underline on a selected text, or masking a selected visible object (See Boys, Column 6, lines 34-43). Sidana and Boys are analogous art because they are from the same field of endeavor of annotating or modifying the contents of web documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the underlining of selected text of Boys with the system and method of processing documents of Sidana. The motivation for doing so would have been to enhance selected web pages and to provide the updated content to users (See Boys, Column 2, lines 42-53). Therefore, it would have been obvious to combine Boys and Sidana for the benefit of enhancing selected web pages and providing the updated content to users to obtain the invention as specified in claims 6 and 12.

As per claims 7 and 14, Sidana and Boys disclose the limitations of claims 1 and 8 as described above. Boys also discloses that the web pages contains education

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materials (See Boys, Column 1, lines 51-67, and Column 2, lines 1-5). Sidana and Boys are analogous art because they are from the same field of endeavor of annotating or modifying the contents of web documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the educational material of Boys with the system and method of processing documents of Sidana. The motivation for doing so would have been to allow educational providers to prepare lectures and the like from existing Web sources and package them for timed execution such that a number of students may learn on-line according to a predetermined schedule, and, in some cases, in real time (See Boys, Column 2, lines 6-12) Therefore, it would have been obvious to combine Boys and Sidana for the benefit of allowing educational providers to prepare lectures and the like from existing Web sources and package them for viewing by students to obtain the invention as specified in claims 7 and 14.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Barbash (U.S. Patent ,826,595 B1) discloses an Internet collaboration system and method.
- Tso (U.S. Publication 2001/0054089 A1) discloses a system and method for providing a guided tour of a Web site.
- Kobayashi discloses collaborative customer services using synchronous Web browser sharing.

- Bouvin discloses unifying strategies for Web augmentation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached at (571) 272-4090.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR



SANJIV SHAH  
PRIMARY EXAMINER